

## REMARKS

By the above amendment, the claims have been amended to clarify features of the present invention and to specifically recite features of data of temperature and humidity of atmosphere as a variable characteristic of the energy consumption and/or a production quantity of the production facility and/or utility facility in which the energy-saving equipment supplies old or warm heat energy. Furthermore, by the present amendment, new claims 26 to 29 reciting further features of the present invention, as discussed above have been presented. Applicants note that the feature of temperature and humidity data as well as production quantity has been previously recited in terms of an operation condition and applicants submit that irrespective of the position set forth by the Examiner, such features cannot be disregarded and are functional features which must be given proper consideration in determining patentability of the claimed invention. Applicants note that the aforementioned features which have been previously recited are described at for example, at page 10, lines 13 - 23 and page 12, lines 15 to page 13, line 2 of the specification. Thus, in accordance with the present invention, the energy service business method and system of the present invention is directed to a production facility and/or a utility facility in which particular types of data are obtained and are correlated with one another for comparison purposes and such features, as recited must be given proper consideration in determining patentability of the claimed invention.

The rejection of claims 2 - 3, 5 - 8, 10, 12 - 15, 17 and 19 - 23 under 35 USC 103(a) as being unpatentable over Yablonowski et al, is traversed insofar as it is applicable to the present claims and reconsideration and withdrawal of the rejection are respectfully requested.

As to the requirements to support a rejection under 35 USC 103, reference is made to the decision of *As to the requirements to support a rejection under 35 USC 103*, reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under '103 to establish a prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Furthermore, such requirements have been clarified in the recent decision of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) wherein the court in reversing an obviousness rejection indicated that deficiencies of the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge".

The court pointed out:

The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination

of references, simply to "[use] that which the inventor taught against its teacher."... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. (emphasis added)

Irrespective of the Examiner's position concerning Yablonowski et al, this patent discloses a lighting system in which an amount of energy consumption is determined only on the basis of hours of operation of the system. While the Examiner refers to column 6, lines 28 - 38 of Yablonowski et al, applicants note that this portion of the specification only describes obtaining information concerning hours of operation, kilowatt hour rates and existing lighting system component information in which the operating hours also include whether or not a specific area has air conditioning. While the Examiner contends that the general information includes "data related to air conditioning (thereby obviously indicating temperature and humidity data)" (emphasis added), applicants submit that the fact of air conditioning merely indicates that air conditioning is provided or not in a certain area at a certain time and does not provide a disclosure or teaching of data concerning temperature and humidity, irrespective of the position by the Examiner. As noted in the decision of In re Fine, supra, "obvious to try" is not the standard of 35 USC 103 and as pointed out in the decision of In re Lee, supra, it is not proper for the Examiner to utilize what applicant has taught against the teacher. Thus, the Examiner's apparent position that the data can be ignored as non-functional, is improper and represents a hindsight reconstruction attempt of the present invention, based upon the disclosure of applicant herein.

Applicants note that irrespective of the position set forth by the Examiner, Yablonowski et al merely discloses a system and method for monitoring lighting systems. In contradistinction, the present invention is directed to a production facility

and/or a utility facility wherein the amount of energy consumption of the production and/or utility facility which utilizes cold or warm heat energy and obtain data of temperature humidity and/or production quantity as a variable a characteristic of the facility and the energy saving equipment which supplies cold or warm heat energy. Because the characteristic of the heat energy consumption is influenced by temperature, humidity and/or production quantity of the facility, a correct calculation of the energy curtailment quantities before and after taking the energy-saving measures by installation of the energy-saving equipment is required to be performed by comparing past data without the energy saving equipment and present data with the energy-saving equipment of the amount of energy consumption correlated with substantially the same temperature and humidity and/or production quantity, as now recited, and as previously recited in the independent and dependent claims of this application. Applicants submit that such features patentably distinguish over Yablonowski et al in the sense of 35 USC 103, such that all claims present in this application should be considered allowable thereover.

With regard to independent claims 2, 8, 10 and 17, such claims recite the feature that past data in the database are stored in a form correlated with temperature and humidity of atmosphere as a varying characteristic of the energy consumption of the production and/or utility facility as well as the feature of retrieving the past data with which the temperature and humidity agree within a set allowable range corresponding to the measured temperature and humidity data, and calculating energy curtailment quantities by comparing the retrieved past data and the present data. That is, in accordance with the present invention, it is important to obtain the correct information curtailment quantities in which the past data should be stored together with the correlated temperature and humidity data so as to enable a

proper comparison with the measured present data in terms of correlation of temperature and humidity data. That is, since it is difficult to retrieve the past data having a coincident temperature and humidity with the temperature and humidity of the present data, the calculation is effected by retrieving the past data with which the temperature and humidity data agree within a set allowable range corresponding to the measured temperature and humidity data so that a proper comparison and energy curtailment quantities can be determined. The same is true with respect to production quantity data as recited in claims 26 and 28. Applicants submit that all of the independent claims of this application recite one or more of the aforementioned features, which features are not disclosed or taught by Yablonowski et al in the sense of 35 USC 103.

With regard to the Examiner's comments concerning obviousness and the fact that air conditioning obviously indicates temperature and humidity data, applicants specifically note that this position by the Examiner is in error and is not based upon the disclosure of Yablonowski et al which merely points to determining operating hours by an area and whether or not the area has air conditioning. Moreover, column 8, lines 30 - 36 describe the fee as being the difference between "the original power consumption and the new power consumption multiplied by actual hours of operation, multiplied by a power rate, and multiplied by an air conditioning reduction factor." (emphasis added). Furthermore, it is indicated that the "hours of operation, the power rate and the air conditioning reduction factor may be determined through negotiation". (emphasis added) As such, it is apparent that the air conditioning reduction factor is, in all probability, a rate to calculate an effective reduction amount of power consumption of the air conditioning which is reduced by a new lighting system providing a low calorific light. It is additionally noted that Figure 5 of

Yablonowski et al and the corresponding description at column 7, lines 16 - 31, for example, provide no disclosure or teaching regarding the storage of temperature and humidity data in the database together with energy consumption data prior to taking energy-saving measures by installation of energy-saving equipment or data relating to a production quantity. Applicants submit that such features do not represent non-functional data, which applicants submit cannot be ignored, and applicants submit that Yablonowski et al fails to disclose or teach the claimed features as set forth in the independent and dependent claims of this application, in the sense of 35 USC 103 such that all claims patentably distinguish thereover and should be considered allowable.

In view of the above amendments and remarks, applicants submit that all claims present in this application recite features not disclosed or taught by Yablonowski et al which features cannot be ignored in determining patentability and for which Yablonowski et al provides no teaching in the sense of 35 USC 103. Thus, applicants request favorable action in this application.

To the extent necessary, applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 389.40083X00), and please credit any excess fees to such deposit account.

Respectfully submitted,

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